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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,749	08/01/2003	Hiroyuki Azuma	NEC 03P101	4659

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EXAMINER

RIVERO, ALEJANDRO

ART UNIT PAPER NUMBER

2684

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/632,749	<b>Applicant(s)</b> AZUMA, HIROYUKI	
	<b>Examiner</b> Alejandro Rivero	<b>Art Unit</b> 2684	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities:

In page 4 line 18, replace "1103by" with "1103 by".

In page 4 line 22, replace "card]1104" with "card 1104".

In page 12 line 11, replace "subscriberís" with "subscriber's".

Appropriate correction is required.

### ***Drawings***

2. The drawings are objected to because of the following informalities:

In figure 2, element 120 should be marked 1201 (according to the disclosure).

In figure 3, element 130 should be marked 1301 (according to the disclosure).

In figures 7, 8 and 9, several elements have labels in which the letters are crowded into small boxes making it difficult to read (for example elements 209 and 310).

In figure 9, element 301a is not mentioned in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Simpson et al. (US 5,404,580).

Consider claim 1, Simpson et al. disclose an external module (smart card) to be installed in a mobile communication terminal when the mobile communication terminal is in use (Abstract, column 4 lines 49-52), said external module comprising; collection means for communicating with said mobile communication terminal to collect information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2); and storage means for storing therein information

that has been collected by said collection means (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 132).

Consider claim 8, Simpson et al. disclose a mobile communication terminal in which an external module is installed when in use (Abstract, column 4 lines 49-52), said mobile communication terminal comprising: acquisition means (keypad) for acquiring information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2); and output means (microprocessor) for supplying information that has been acquired by said acquisition means to said external module (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 122).

Consider claim 9, Simpson et al. disclose a mobile communication system comprising: a mobile communication terminal (Abstract); and an external module that is installed in said mobile communication terminal when said mobile communication terminal is in use (Abstract, column 4 lines 49-52); wherein said mobile communication terminal comprises: acquisition means (keypad) for acquiring information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2); and output means (microprocessor) for supplying information that has been acquired by said acquisition means to said external module (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 122); and wherein said external module comprises: collection means for collecting information that has been supplied by said output means of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2); and storage means for storing therein information that has been collected by said collection means (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 132).

Consider claim 10, Simpson et al. disclose a method for testing communication protocol in a mobile communication terminal (Column 1 lines 16-30, column 2 lines 65-68, column 3 lines 1-4), an external module being installed in said mobile communication terminal when said mobile communication terminal is in use (Abstract, column 4 lines 49-52), said method comprising steps of: requesting said mobile communication terminal, by said external module, to execute a communication protocol sequence (Column 4 lines 53-56, where Simpson et al. describe a registration request); executing, by said mobile communication terminal, said communication protocol sequence in accordance with said request by said external module (Column 4 lines 56-57, where Simpson et al. disclose a registered subscriber); acquiring, by said mobile communication terminal (keypad), information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2); supplying, by said mobile communication terminal (microprocessor), the acquired information to said external module (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 122); collecting, by said external module, information that has been supplied by said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2); and storing, by said external module, the collected information (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 132).

Consider claims 2, 3 and 11, Simpson et al. disclose all the limitations as applied to claims 1 and 10 above and also disclose protocol execution means for requesting said mobile communication terminal to execute a communication protocol sequence (Column 4 lines 53-56, where Simpson et al. describe a registration request, reads on

claim 2) and protocol execution means includes means for requesting the execution of said communication protocol sequence based on information that has been stored in said storage means (Column 4 lines 53-56, where Simpson et al. disclose a subscriber validation code, reads on claim 3) and wherein said step of requesting to execute a communication protocol sequence includes requesting, by said external module to execute said communication protocol sequence based on information that is stored (Column 4 lines 53-56, where Simpson et al. disclose a subscriber validation code, reads on claim 11).

Consider claims 4 and 12, Simpson et al. disclose all the limitations as applied to claims 2 and 10 above and also disclose wherein said communication protocol sequence is a communication protocol sequence that is performed by radio between a mobile communication terminal and a base station (Column 4 lines 53-56, reads on claim 4) and wherein said step of executing a communication protocol sequence includes execution by said mobile communication terminal of a communication protocol sequence by radio with a base station (Column 4 lines 53-56, reads on claim 12).

Consider claims 5 and 13, Simpson et al. disclose all the limitations as applied to claims 1 and 10 above and also disclose stored information processing means (microprocessor) for processing information that has been stored in said storage means (Column 4 lines 49-56, reads on claim 5) and processing information that is stored in said external module (Column 4 lines 49-56, reads on claim 13).

Consider claims 6 and 14, Simpson et al. disclose all the limitations as applied to claims 5 and 13 above and also disclose wherein said protocol execution means

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includes means for requesting the execution of a communication protocol sequence (registration) based on information (subscriber validation code) that has been processed by said stored information processing means (Column 4 lines 53-57, reads on claim 6) and wherein said step of executing a communication protocol sequence includes requesting, by said external module, execution of a communication protocol sequence (registration) based on information (subscriber validation code) that has been processed (Column 4 lines 53-57, reads on claim 14).

Consider claims 7 and 15, Simpson et al. disclose all the limitations as applied to claims 1 and 10 above and also disclose wherein said external module is any one of a SIM card (smart card), a USIM card, and an IC card having higher specifications than a SIM card or USIM card (Abstract, reads on claims 7 and 15).

### ***Conclusion***

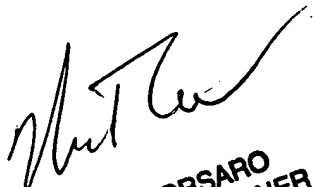
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alejandro Rivero whose telephone number is (571) 272-2839. The examiner can normally be reached M-F, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on (571) 272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AR



NICK CORSARO  
PRIMARY EXAMINER